



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,475	12/05/2003	Steve Pakola	113476.122US1	3082

23483 7590 01/10/2007
WILMER CUTLER PICKERING HALE AND DORR LLP
60 STATE STREET
BOSTON, MA 02109

EXAMINER

FORD, ALLISON M

ART UNIT	PAPER NUMBER
----------	--------------

1651

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
31 DAYS	01/10/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 31-DAYS from 01/10/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

teresa.carvalho@wilmerhale.com
tina.dougal@wilmerhale.com
michael.mathewson@wilmerhale.com

Office Action Summary	Application No. 10/729,475	Applicant(s) PAKOLA ET AL.	
	Examiner Allison M. Ford	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 57-84 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

In response to the second restriction requirement, mailed 17 April 2006, applicants elected, with traverse, the invention of Group I, claims 57-61, 63-72 and 80-84, drawn to a method of treating a vitreoretinal disease or disorder, or a complication thereof, of an eye of a subject having such a disease or disorder. The traversal is on the ground(s) that search and consideration of both inventions would not pose a serious burden on the examiner; and thus restriction according to MPEP § 803 is not proper.

This is not found persuasive because, as discussed in the restriction requirement, the different inventions are intended for different populations, thus a reference which would anticipate or render obvious claims of one group would not necessarily anticipate or render obvious claims of another group. The different inventions each had different main classifications, which is demonstrative of the divergent searches which would need to be conducted for each invention. Additionally a thorough search of all non-patent literature related to each of the distinct groups would, in fact, pose a serious burden on the examiner. The requirement is still deemed proper and is therefore made FINAL.

It is further noted that claim 61 (dependent on linking claim 57) was included in both Groups I and II, applicants suggested this may have been in error, as claim 61 is directed to a method of treatment, not prevention; however, while applicants suggestion is appreciated, inclusion of claim 61 in both groups was intentional. Claim 61 recites embodiments wherein the method is used for (i) treating a subject *having* a vitreoretinal disorder (interpreted to limit the method to *treatment* of a subject *already having* said disorder); and (ii) treating a subject *at risk of developing* a vitreoretinal disorder (interpreted to limit the method to method of *preventing* said disorder, in a subject *who does not* have the disorder, but is at risk of developing such). Because applicants elected the method of treating a subject already having a

Art Unit: 1651

vitreoretinal disorder, claim 61 will be examined only as far as it reads on treating a subject *having* a vitreoretinal disease or disorder (method of Group I).

Regarding the election of species requirement, applicants elected the species of (a) recombinant microplasmin; traversing the requirement, citing MPEP § 803.02, arguing that because the members of the instant Markush group are so few in number that a search and examination can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits.

The Office has reconsidered the election of species requirement, the following NEW requirement to elect a single species for initial prosecution is hereby set forth:

Upon review of the application it is noted that the term 'microplasmin' does not refer to a specific, single molecule or compound, but rather is intended as a term that generally encompasses hundreds of possible sequence variants. Table 1 in the specification, which spans pages 20-30 provides a 'non-limiting' list of possible sequence variants which are encompassed by the term 'microplasmin'. The number and diversity of the various sequence variants to which the current claims are generic to, are not considered to be sufficiently few in number of so closely related that a search and examination of the entire scope of the claims can be made without serious burden on the Office; therefore, applicants are herein required to elect a single sequence, representative of a single, specific truncated protein sequence which comprises the catalytically active domain of the plasmin protein, for initial examination in the method under consideration.

The species of microplasmins are listed in the specification at pages 20-30. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Art Unit: 1651

Should applicant traverse on the ground that any of the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

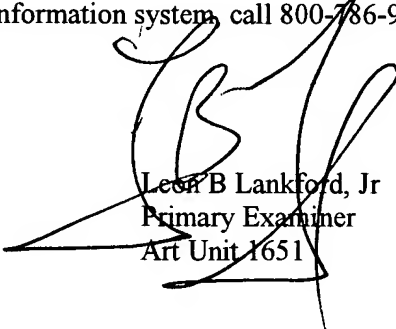
The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allison M. Ford whose telephone number is 571-272-2936. The examiner can normally be reached on 7:30-5 M-Th, alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1651

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Leon B Lankford, Jr
Primary Examiner
Art Unit 1651